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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,133	01/19/2001	Jonathan E. Lowthert	42390P10893	9485

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EXAMINER

RAMAN, USHA

ART UNIT PAPER NUMBER

2623

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/766,133

Applicant(s)

LOWTHERT ET AL.

Examiner

Usha Raman

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments, see page 13, filed August 28th, 2006, with respect to the rejection(s) of claim(s) 30 under Zigmond have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Knepper.
2. Applicant's arguments with respect to claims 27, and 31-32 have been fully considered but they are not persuasive. Applicant traverses rejection of claim 27 under Zigmond stating that, "ad selection criteria have nothing to do with identifying a location to insert an advertisement". However the examiner notes that the claim recites, "*an interface...to utilize the information segment to identify a content location and an advertisement*". Zigmond teaches the step of identifying triggers in a media content and utilizing the detected triggers in conjunction with the information segment to identify content location and an advertisement. See column 15, lines 40-45. As a result, the examiner maintains rejection of claims 27, and 31-34 under Zigmond.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Knepper et al. (US PG Pub. 2001/0042249).

With regards to claim 27, Knepper discloses a receiver (client receiver) to receive content (media files) with an information segment (instruction set) and a plurality of advertisements (advertisement files);

A cache (client side storage), coupled to said receiver to store the content with information segment and advertisement (see [0008], [0009], [0014], advertisements, media files, and information segment are downloaded and pre-cached at client side);

An interface (client side application software) in the receiver to utilize information segment to identify a content location (location identified via ADInsert tags) and an advertisement (see [0081]-[0083]), out of the plurality of advertisements, to insert in the location, the interface (client side application) to utilize the information segment (instruction set) to identify the location while the content is still stored in cache (i.e. content is still stored in cache during playback of media files as well as advertisements).

With regards to claim 28, the interface in the system utilizes an info segment (instruction set) with an interruption point specifier (ADInsert tag) to indicate a point to insert the advertisement in the content. See [0052], [0055] and [0059]

With regards to claim 29, the interface in the system utilizes an info segment having a plurality of fields, one field comprising an interruption point specifier (ADInsert tag) to indicate a point to insert the advertisement in the content, another

field indicating a permitted ad type specifier (CPCLSI), a prohibited ad type specifier (CPCLSE), and an ad lock (EADOK). See [0080]-[0081].

With regards to claim 30, the interface utilizes an info segment having an ad entry (commands between <ADInsert> and </ADInsert>), the ad entry having the plurality of fields as discussed in claim 29 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 27, 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US Pat. 6,698,020).

A receiver (80) to receive content with an information segment (ad selection criteria, see column 11, lines 50-53, lines 66-67, and column 12 lines 1-9) and a plurality of advertisements (see fig. 5);

A cache coupled to the receiver to store content with the information segment (see column 11, lines 30-35) and advertisement (86, column 4, lines 21-23, column 15, lines 24-25); and

An interface in said receiver (computer executable instruction identifying a triggering event, see column 15, lines 40-45 to determine when to insert ads) to utilize the information segment to identify a content location (content location

identified by trigger) and an advertisement (ad identified by info segment utilized upon detection of a trigger, see column 12, lines 33-43, and lines 47-51), out of plurality of advertisements, to insert in the location (see column 11, lines 31-35, column 12, lines 47-51), the interface to utilize the information segment to identify the location while the content is still stored in storage medium (i.e. when programming source is storage medium, the content is still stored in storage medium).

Zigmond does not disclose that the storage medium (e.g. video tape) providing the content comprises a cache.

Examiner takes official notice that cache was well known at the time of the invention, as used to store data requiring fast retrieval access.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system to include a cache as the storage medium for providing programming content, thereby enabling fast retrieval of content.

In regards to claim 31, the modified system comprises the cache storing an electronic programming guide having a program identifier (see column 10, lines 64-67, column 11 lines 1-2) and an associated info segment (see column 11, lines 43-47), the electronic programming guide enabling locating the info segment corresponding to a selected program (column 11, lines 43-47, column 12, lines 60-62, lines 47-51).

In regards to claim 32, the modified system comprises a television receiver (see column 6, lines 34-44).

In regards to claim 33, the modified system lacks a presentation device connected to the system via a wireless connection.

Examiner takes official notice that it was well known at the time of the invention to use a presentation device coupled to a system over a wireless link.

It would have been obvious to one of ordinary skill in the art at the time of the invention to further modify the system to include a presentation device for presenting data over a wireless link. The motivation is to be able to present data to a user over wireless presentation devices.

In regards to claim 34, the system discloses that location for insertion are identified by triggers, however does not indicate that the location is where the sound volume goes to zero.

Examiner takes official notice that audio and video breaks (i.e. low volume, blank video frames) indicating beginning and end of advertisement slot in programming broadcasts were well known in the art at the time of the invention. It would be further obvious to include zero audio to indicate the breaks, so that the trigger for a commercial slot is detectable by the receiver system.

It would have been obvious to one of ordinary skill in the art at the time of the invention to detect zero volume "breaks" in a telecast and identify it as the location for advertisement placement. The motivation is to place advertisement in locations that broadcaster has indicated for advertisements to be placed at.

Conclusion


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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UR


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